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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,074	06/25/2004	Kazuaki Sakaki	0171-1120PUS1	5329

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EXAMINER	
SHEEHAN, JOHN P	

ART UNIT	PAPER NUMBER
1742	

NOTIFICATION DATE	DELIVERY MODE
06/22/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/500,074	SAKAKI ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 6/04 11/06 3/07.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed June 25, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The Examiner did not receive a copy of Japanese reference Nos. 6-140218; 6-108190; 2001-167917; 5-226125; 2000-232011; and 2002-184615. The Examiner considered the remaining references cited in the IDS.

3. The information disclosure statement submitted November 13, 2006 appears to contains a typographical error. Reference BA is listed as Japanese document No. 5608109, however applicants submitted a copy of JP 5681908 and refer to JP 5681908 in paragraph III(b) of the IDS. In view of this, the Examiner has lined through reference BA and cited JP 5681908 on the FORM PTO-892 attached to this Office action, it is

noted that since applicants are in possession of a copy of JP 5681908 no copy of this reference is being sent to applicants.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document 2002-118009 (Japan '009, cited in the IDS submitted June 25, 2004).

Japan '009 teaches a Sm-Fe-Cu-Zr-Co sintered magnet having a composition that overlaps the Sm-Fe-Cu-Zr-Co sintered magnet composition recited in the instant claims. Japan '009's magnet is coated with an oxide layer as recited in the instant claims (see the English language abstract submitted with the IDS).

Japan '009 and the claims differ in that Japan '009 does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the Sm-Fe-Cu-Zr-Co sintered magnet composition taught by Japan '009 overlaps the instantly claimed proportions and therefore is considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the

disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

6. Claims 7 to 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Nishiuchi et al. (Nishiuchi '196, US Patent No. 6,251,196, cited in the IDS submitted June 25, 2004) or Nishiuchi et al. (Nishiuchi '590, US Patent Publication No. 2001/0030590, cited by the Examiner).

Each of the references a teaches rare earth-iron-boron sintered magnet having a composition that overlaps the rare earth-iron-boron sintered magnet composition recited in the instant claims (Nishiuchi '196, column 9, line 43 to column 10, line 23 and Nishiuchi '590, paragraphs 0059 to 0065). Each of the references teaches that the sintered rare earth-iron-boron magnet is prepared as recited in the instant claims (Nishiuchi '196, column 10, lines 43 to 61 and Nishiuchi '590, paragraph 0068). The so formed sintered magnet is plated with a metal and heat treated as recited in the instant claims under process conditions that overlap the process conditions recited in the instant claims (Nishiuchi '196, column 5, lines 4 to 15 and Nishiuchi '590, paragraphs 0025 and 27). The heat treated metal coated rare earth-iron-boron sintered magnets

are then coated with an oxide (Nishiuchi '196, column 5, lines 15 to 25 and Nishiuchi '590, paragraph 0012).

Nishiuchi '196 and Nishiuchi '590 and the claims differ in that Nishiuchi'196 and Nishiuchi '590 do not teach the exact same rare earth-iron-boron alloy proportions or the exact same heat treatment conditions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the rare earth-iron-boron alloy proportions and the heat treatment conditions taught by each of Nishiuchi '196 and Nishiuchi '590 overlap the instantly claimed rare earth-iron-boron alloy proportions and the heat treatment conditions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 4 to 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 24 of U.S. Patent No. 6,623,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the oxide coated Sm-Fe-Cu-Zr-Co sintered magnet recited in these two sets of claims overlap, thereby establishing a prima facie case of obviousness.

9. Claims 4 to 6 are directed to an invention not patentably distinct from claims 1 to 24 of commonly assigned US Patent No. 6,623,541. Specifically, they are not patentably distinct from each other because the oxide coated Sm-Fe-Cu-Zr-Co sintered magnet recited in these two sets of claims overlap, thereby establishing a prima facie case of obviousness.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

Chapter 2300). Commonly assigned US Patent No. 6,623,541, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

10. Claims 4 to 6 are rejected under 35 U.S.C. 103(a) as being obvious over US Patent No. 6,623,541.

11. The applied reference has a common assignee and common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not

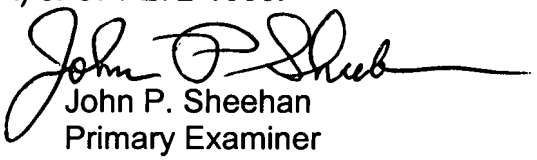
claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). The instant claims are not patentably distinct from US Patent No. 6,623,541 because the oxide coated Sm-Fe-Cu-Zr-Co sintered magnet taught by US Patent No. 6,623,541 overlaps the instantly claimed oxide coated Sm-Fe-Cu-Zr-Co sintered magnet, thereby establishing a prima facie case of obviousness.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Sheehan
Primary Examiner
Art Unit 1742

Jps